

REMARKS

Applicant has carefully studied the Office Action of 18 March 2003 and offers the following remarks.

Claims 47-49, 51-62 and 64-70 were rejected under 35 U.S.C. § 103 as being obvious over Inniss et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where the reference or combination of references shows each and every claim element. MPEP § 2143.03. Where the Patent Office modifies a single reference to construct an obviousness rejection, the Patent Office must make particularized findings about the motivation to modify the reference. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

In its analysis of independent claims 47 and 59, the Patent Office admits that Inniss et al. does not show the audio package builder/export tool adapted to construct an index file within the audio package that indicates to the gateway where in the audio package an audio segment may be located, or that the gateway is the intended recipient of the audio message. The Patent Office attempts to rectify this deficiency by indicating that data stream 172 indicates an index file within the audio package. Applicant respectfully traverses this assertion. Applicant has studied the reference, particularly column 9, lines 38-52, wherein data stream 172 and Figure 7 are discussed. Data stream 172 is the audio package and there is nothing in elements 174, 176, 178, 180, or 182 that can be construed as an index file. The Patent Office's only analysis as to a motivation to modify the reference to include an index file is the statement "it would have been obvious for one of ordinary skill in the art . . . to modify the Inniss system and method by including the step of constructing an index file and the recipient is a gateway, by doing this, an audio message could be searched, retrieved by a recipient such as a gateway." However, this motivation is not present in the reference or the prior art. The MPEP indicates that the suggestion to modify the references or combine the references must come from the prior art, not Applicant's disclosure. MPEP § 2143. Applicant's disclosure is the only place that there is a suggestion that it is desirable to search the audio message. Additionally, the broad conclusory nature of this finding is exactly the sort of broad conclusory statement that was rejected in *Dembiczak*. Thus, the Patent Office has not made the requisite findings to modify the reference to include such an index file in the audio package. To this extent, the Patent Office has not shown a claim element and thus the Patent Office has not established *prima facie* obviousness.

The Patent Office makes a further error in its analysis of the reference by indicating that because the network 18 may perform a variety of other functions "the audio message as discussed above could be transferred to a gateway as a recipient." (Office Action, page 5, emphasis added). Merely because something could be modified is insufficient to establish *prima facie* obviousness. MPEP § 2143.01. The fact that the Inniss system could be modified to send an audio message with multiple parts to a gateway is insufficient to support a finding of obviousness absent a teaching or suggestion in the prior art to make the modification.

Further, the theoretical modifications suggested by the Examiner to the Inniss system would render the Inniss system unsatisfactory for its intended purpose. Specifically, if the Patent Office's modification is carried out, the voice mail systems to which Inniss sends his audio messages will be unable to process the audio message, defeating the purpose of the Inniss system. Since the modification renders the Inniss system unsatisfactory for its intended purpose, the claim is non-obvious over the Inniss system. MPEP § 2143.01. Thus, claims 47 and 59 are non-obvious over the rejection of record and stand in a condition for allowance.

Claims 48, 49, and 51-58 depend from claim 47 and are patentable at least for the same reasons that claim 47 is patentable. Claims 60-62, and 64-70 depend from claim 59 and are patentable at least for the same reasons that claim 59 is patentable.

Claims 48 and 61 deserve special mention. Claims 48 and 61 recite a catalog file within the audio package. The Patent Office opines that Figures 6 and 7 show this element without analysis. Figure 6 is the correlation database, not the audio package. Figure 7 shows no catalog file within data stream 172. To this extent, the Patent Office has failed to show another claim element and has not established *prima facie* obviousness with respect to these claims.

Claims 50 and 63 were rejected under 35 U.S.C. § 103 as being unpatentable over Inniss et al. in view of Anderson et al. Applicant respectfully traverses. The standard for establishing *prima facie* obviousness is set forth above. Initially, Applicant notes that the Patent Office has not advanced a compelling motivation to combine the references. The Patent Office opines that "it would have been obvious...to modify the Inniss system and method by exporting the audio package over a packet based network to have a quality real-time communication." This sort of conclusory statement is prohibited by *Dembiczak*. The Patent Office must make a particularized finding as to where in the reference or the art this motivation would have arisen. Since the Patent Office has not made the required findings, the Patent Office has not provided a proper

motivation to combine the references. Applicant then notes that, as explained above, Inniss et al. does not teach or suggest all the elements of the underlying independent claims. Nothing in Anderson et al. provides the missing elements. Since neither reference individually teaches nor suggests the recited claim elements, the combination of references cannot teach or suggest the recited claim elements. Thus, even if the references are properly combinable, the combination does not establish *prima facie* obviousness. Still further, the modifications to Inniss that would be required to effectuate the combination would render Inniss unsuitable for the intended purpose of Inniss. By rendering Inniss unsuitable for its intended purpose, the Patent Office confirms that the combination does not make the claim obvious, or at a minimum undercuts the motivation to combine the references. Since the combination is improper and does not show the claimed invention, the claims define over the rejection of record and are in a condition for allowance.

Applicant requests reconsideration of the rejection based on the remarks presented herein. Specifically, the references do not show or suggest the index file or the audio file being sent to a gateway. Because the references do not show or suggest a claim element, the claims are non-obvious over the rejection of record and stand in a condition for allowance. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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